

01



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,339	07/31/2001	Darin Scoville McClure	60003.0001USU1	2737

7590 03/02/2006

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903

EXAMINER
----------

GOTTSCHALK, MARTIN A

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/919,339

Applicant(s)

MCCLURE ET AL.

Examiner

Martin A. Gottschalk

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-22 have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 1 recites "inputting information...onto a server Website". There are several potential many of "website" that would cause the claim to be interpreted differently depending on which meaning was adopted. For instance, a website could be the content displayed on a web page; the various links attached to a so-called "home page"; files stored on certain server hardware; and so on. Another reasonable interpretation of the phrase "server Website" could be a website whose content pertains particularly to the subject of servers. However, the context of the claim as a whole, for instance in view of the preamble of claim 1, does not strongly support this interpretation. Correction is required. For the purpose of examination, the Examiner will interpret the phrase "server Website" to read "server."

***Claim Rejections - 35 USC § 103***

Art Unit: 3626

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (PG Pub# US 2002/0010601) in view of McCormack et al (US Pat# 6,049,773).

A. As per claim 1, Taylor discloses a computer-implemented method for generating historical claim loss data reports that combine loss data from multiple insurance carriers over multiple years for insured parties comprising the steps of:

Art Unit: 3626

- (a) inputting information about the insured onto a server Website (Taylor: inputting, [0008] – [0013]; [0045] – [0046]; Fig 2; server, [0066]; Fig 4, items 18 and 26));
- (b) obtaining an authorization from the insured party (Taylor: [0050]);
- (f) distributing the reports to the user (Taylor: [0053]).

Taylor suggests but fails to explicitly disclose

- (c) querying loss data from at least two carrier databases;
- (d) storing the queried loss data in a standard formatted form
- (e) generating a standardized report, wherein the report combines loss data from the at least two carrier databases; and

However, these features are well known in the art as evidenced by the teachings of McCormack. McCormack discloses

- (c) querying loss data from at least two carrier databases (McCormack: col 6, ln 58 to col 7; col 12, lns 61-65; Fig 3, items 100-500 show multiple databases which the Examiner notes are operated by a carrier, col 3, lns 47-52);

Art Unit: 3626

(d) storing the queried loss data in a standard formatted form (McCormack: col 7, Ins 10-14; Fig 3, item 2000)

(e) generating a standardized report, wherein the report combines loss data from the at least two carrier databases (McCormack: col 4, Ins 51-53; col 23, Ins 3-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of McCormack with the disclosures of Taylor with the motivation of utilizing the approaches of neural networks and fuzzy logic (McCormack: col 3, Ins 25-37) to more efficiently match every tenant, owner, and insurance coverage (Taylor: [0021]) in the absence of complete information (McCormack: col 2, Ins 52-55).

Note: In the rejections of claims 11-13 which follow in this section, the motivation to combine the teachings of Taylor and McCormack is as provided above for claim 1.

B. As per claim 2, Taylor discloses the method according to claim 1, wherein the step of inputting the information about the insured comprises

Art Unit: 3626

inputting the information about the insured through a user interface on the server Website (Taylor: Figs 1 and 2).

C. As per claims 3 and 4, Taylor discloses the method according to claim 1, further comprising the step of

(claim 3) implementing a security procedure that limits access to predetermined users.

(claim 4) receiving a Login Name from the user;

receiving a Password from the user; and

verifying that the received Login Name and Password have authorization to enter the secured area (applies to all the steps above for claims 3 and 4, Taylor: Fig 10; [0050] – [0051]; [0055]).

D. As per claim 5, Taylor discloses the method according to claim 1, wherein

before the step of inputting information about the insured onto a server Website the user, through a user menu driven interface on the server Website, chooses a report request (Taylor: reports, [0056]; [0054] – [0055], insured reads on “user”. Note that information about a report can

Art Unit: 3626

be requested at any time, both before and after user information is entered.).

E. As per claim 6, Taylor discloses the method according to claim 1, further comprising the step of

flagging an account as authorized on the server Website, wherein the account is flagged on the server Website after the step of obtaining an authorization from the insured party is completed (Taylor: [0023], flagging and account reads on "...generates...reports...listing...uninsured tenants...; see also [0079]).

F. As per claim 11, McCormack discloses the method according to claim 1, wherein the step of querying loss data from at least two carrier databases comprises the steps of:

triggering the query at pre-determined times (McCormack: col 7, lns 21-40, the note that querying the LOSSTYPES, Fig 3, item 200 database occurs sequentially following the input of the Raw Claims Data, item 100. The Examiner considers this to be a form of a pre-determined time.); and querying only for the loss runs of flagged accounts (McCormack: col 10, lns 20-24).



G. As per claim 12, McCormack discloses the method according to claim 11, wherein the step of querying loss data from at least two carrier databases further comprises

determining the appropriate protocol according to which carrier database is queried (McCormack: col 7, lns 21-40, note that the LOSSTYPES, CITY2LAT, and TEL2AT databases perform different functions, i.e. they perform according to different protocols, and these protocols are determined during the process when data is passed to the steps involving these databases.).

H. As per claim 13, McCormack discloses the method according to claim 1, wherein the step of storing the queried loss data in a standard formatted form comprises the steps of:

selecting the appropriate mapping scheme according to the carrier queried;

mapping the data fields of the carrier loss run data fields to fields in a standard formatted record; and

Art Unit: 3626

adding addition fields to that standard formatted record (McCormack: col 6, ln 65 to col 7, ln 21 for all of the above steps).

I. As per claim 14, Taylor discloses the method according to claim 1, wherein the step of generating a standardized report comprises the steps of:

generating a detail report for each line of business; and

generating a summary report for each line of business, wherein the summary report combines at least two carriers within the same line of business (Taylor: [0021] for both steps of claim 14.).

J. As per claim 15, Taylor discloses the method according to claim 1, wherein the step of distributing the report to the user comprises the steps of:

inputting a notification list on the server Website (Taylor: [0021]; Fig 12);

emailing the parties on the notification list upon completion of the report (Taylor: [0021]; Fig 14, note the email address of recipient); and

accessing reports via World Wide Web by members on the notification list (Taylor: Fig 12).

K. As per claim 16, Taylor discloses the method according to claim 1, wherein the step of distributing the report to the user comprises the steps of:

inputting a notification list on the server Website (Taylor: [0021]; Fig 12);

emailing the parties on the notification list an URL address and a Password; accessing that Internet address; receiving that Password; verifying that that Password is an authorized Password; and viewing the reports (Taylor: Fig 10; [0050] – [0051]; [0055]).

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of McCormack and further in view of Applicant's admitted prior art submitted in the disclosure for the current application (hereinafter APA).

A. As per claim 7, the combined teachings of Taylor and McCormack teach the method according to claim 1, wherein the step of obtaining an authorization from the insured party comprises the steps of:

generating (from application software), printing and storing insurance - related information from an insured or potentially insured (Taylor: [0028] - [0029]) ; and

Art Unit: 3626

collecting information from a user via a plurality of channels (Taylor: [0012]  
– [0013]);

The combined teachings fail to explicitly teach the above steps as applied to “authorization letters” which pertain to obtaining authorization from an insured to disclose loss data from the insured's history, namely

generating authorization letters on an application on the server Website;

printing authorization letters;

obtaining insured signatures on letters;

returning authorization letters via facsimile; and

storing authorization letters.

However, these features are well known in the art as evidenced by APA (APA: pg 2, lns 16-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Applicant's admitted prior art with the combined teachings of Taylor and McCormack with the motivation of allowing

Art Unit: 3626

more efficient and complete collection of tenant information in order to assure compliance with renter's agreements requiring a tenant to maintain insurance (Taylor: [0005]).

Note: In the rejections of claim 9 which follows in this section, the motivation to combine the teachings of Taylor, McCormack, and APA is as provided above for claim 1.

B. As per claim 8, Taylor discloses the method according to claim 7, wherein the step of printing the authorization letters comprises of the user printing authorization letters which have

unique tracking numbers (Taylor: [0012], the Examiner the disclosing coding to include a unique tracking number for a tenant) or  
  
bar codes.

C. As per claim 9, APA discloses the method according to claim 8, wherein the step of storing the authorization letters comprises of

routing the authorization letters according to account to storage areas (APA: pg 2, ln 21, reads on "...very labor intensive." The Examiner

Art Unit: 3626

considers routing the letters to include for example the labor intensive practice of receiving the faxed documents and filing them.).

D. As per claim 10. Taylor and McCormack discloses the method according to claim 9, wherein the step of storing the authorization letters further comprises the steps of:

interfacing the routing system and the server Website (Taylor: Fig 4, items 20 and 22; [0049]); and

flagging the account on the server Website when the routing system has received all of the authorization letters for that account (McCormack: col 10, lns 20-24).

8. As per claims 17-22, they are system claims which repeat the same limitations of claims 1, 3, 8-10 and the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of Taylor, McCormack and APA disclose the underlying process steps that constitute the methods of claims 1, 3, and 8-10, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 17-22 are rejected for the same reasons given above for claims 1, 3, and 8-10.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied patent prior art discloses systems that collect and report insurance claim loss data (US Pat# 6,009,402; 6,182,566; and PG Pub# 2002/0103750), a system for printing barcodes onto letters and other documents (US Pat# 6,182,566).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MG  
12/06/05



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER